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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86184669
Applicant	Your Holding BV
Applied for Mark	YOURHOSTING
Correspondence Address	YOUR HOLDING BV CEINTUURBAAN 28 AA ZWOLLE, 8024 NETHERLANDS b.carlier@yourhosting.nl, b.carlier@yourhosting.nl
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Filer's Name	Valentijn Borstlap
Filer's e-mail	b.carlier@yourhosting.nl
Signature	/Valentijn Borstlap-1976/
Date	11/24/2015

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Serial No.: 86184669
Trademark: YOURHOSTING
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EX PARTE APPEAL

APPLICANT'S REPLY BRIEF

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The Applicant, Your Holding BV, hereby respectfully replies to the Examining Attorney's Appeal Brief of November 12, 2015.

Record Description

For a description of the record so far, we like to refer to the same section in our Appeal Brief of September 7, 2015.

The examining attorney has replied to our Appeal Brief at November 12, 2015 to affirm the refusal to register our trademark 'Yourhosting' in the Principal Register of the federal trademark registration system for the applied services in the IC's 38, 42 and 45, on the grounds of descriptiveness under the Trademark Act section 2(e)(1).

B. ATTORNEY'S EVIDENCE

November 12, 2015 Examining Attorney's Appeal Brief

Basically the examining attorney maintains her view that our trademark is descriptive for its services in whatever sense. It's descriptive because the term hosting describes all our services and the composition of the terms your and hosting does not change that. The main new evidence presented in the examiner's appeal brief are attached dictionary definitions from the American Heritage Dictionary for the definitions of 'your' and 'hosting'.

C. OUR EVIDENCE

November 24, 2014 Reply on Examining Attorney's Appeal Brief

See all the evidence attachments in our Request for Reconsideration filed on June 23.

Argument Section

A. TO DETERMINE

The issue at hand is for the Trademark Trial and Appeal Board (further indicated as the 'Board') to determine whether the term YOURHOSTING is merely descriptive as related to the purposes of Section 2(e)(1) of the Trade Mark Act, in connection with the services in IC Classes 38, 42 and 45 respectively:

- Providing access to telecommunication networks; information about telecommunication; providing electronic telecommunications connections; telecommunications routing and junction services; providing telecommunications connections to a global computer network; transfer of data by telecommunications; telecommunications by e-mail
(IC 38, based on intent to use)
- Design, creation, hosting, maintenance of websites for others; design, creation, hosting and maintenance of internet sites for third parties; Hosting the software, websites and other computer applications of others on a virtual private server.
(IC 42, based on intent to use)
- Domain name registration services
(IC 45, based on 44(e))

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B. ARGUMENT

Contra-arguments against the arguments in the Examiner's Brief

In our "second term" we wish to restrict our reply by not repeating all our arguments as supplied in our appeal but to systematically answer to the arguments raised by the examiner in her appeal brief. This will lighten the dispute between the examiner and us more clearly and will enhance the readability of our reply in this matter.

First we like to address the examiner's arguments raised in her appeal brief under II.B.

The arguments raised here are mainly evidenced by excerpts from online dictionary definitions, one commercial webpage from a service provider Hostgator and webpages from Wikipedia.

Although this evidence explains something about the activities of an internet service provider or ISP, there are by no means definitive sources and furthermore nowhere in this presented evidence is there direct support for the claim of the examiner that the term 'hosting' is descriptive for the services named under the IC's 38 and 45 respectively Telecom services and Domain name registration services.

The evidence presented under footnote 2 (Dictionary definitions from *American Heritage*

Dictionary for the term “hosting” do not mention the terms “Telecom services” or “Domain name registration services”. The cited pages from Wikipedia and one arbitrary commercial website from Hostgator, do offer some explanatory information about webhosting but do not offer substantial evidence that the average consumer will immediately see hosting as a descriptor of Telecom - and Domain name registration services. We further supported our argument that hosting does not imply automatically the other services applied for under the IC’s 38 and 45 (telecom- and domainname services) by compiling a list of firms that provide these services independent of each other. See the attached evidence from our Request for Reconsideration summarized under 2, A, B & C. This further stresses our view that the examiner widens the scope of the term hosting artificially even if the evidence she presented in the Dictionary definitions does not even mention Telecom- and Domainname registration services. We therefore maintain our stance that hosting and thereby Yourhosting is not descriptive for our services under the IC’s 38 & 45 being Telecom- and Domainname registration services.

Secondly we like to address the examiner’s arguments raised in her appeal brief under II.C.

The examiner did not understand or read well our argument that the composite term ‘Yourhosting’ does leave the average customer in a state of uncertainty what to make of the ‘your’ part in the expression Yourhosting because there’s no such thing as hosting one’s own website. The examiner states in her appeal that our argument that the composite mark of the terms ‘your’ and ‘hosting’ gives it a suggestive meaning, is centered around the fact that hosting has several other meanings like hosting accommodations at an inn. This is totally not the case. We never did state that or even implied it.

The term Yourhosting puts the average customer on the wrong track, it suggest something that’s not the case in the sense that we as an ISP would provide a service that makes it possible to host one’s own website which is not the case, is in fact never the case when one chooses an ISP to host pages for you. It’s rather a suggestive ‘At your Service’ attitude that combined with the context of the services does not immediately convey its meaning. So we argue that the composition of the terms ‘your’ and ‘hosting’ makes the nature of our application ‘Yourhosting’ more suggestive than descriptive.

It’s our view that the examiner did not establish that the compound term ‘Yourhosting’, by unifying the words ‘your’ and ‘hosting’, retains the descriptive nature of the terms apart (as she claims in section II.B of her Appeal Brief). The examiner’s records like dictionaries definitions or other sources does not provide any evidence that the mark as a whole is a generic descriptive term for the relevant public.

Furthermore as stated in our Request for Reconsideration ‘merely descriptive’ means not in one way or another descriptive but in an immediate and direct sense in context with the services and goods where the mark is applied for.

We do not understand the examiner's sudden introduction of the telescoped phrase/telescoped mark description (TMEP 1213.05(a)(i)) of our trademark application. There is to our knowledge no sharing of letters in the term Yourhosting intentional or unintentional.

Thirdly we like to address the examiner's arguments raised in her appeal brief under II.D.

Although the examiner states that prior decisions and actions of other trademark attorneys in registering other marks have little evidentiary value and are not binding upon your board. While this is the case the following compound US registrations do not differ from the compound application we wish to register:

U.S. Registration Numbers:

2888958 (Myhosting), 4086260 (Edgewebhosting), 4401599 (Jetwebhosting), 4713453 (HostingRage), 4650147 (Your Server, Your Data, Your Terms!) and 4632304 (Your Vision In Motion Pictures). These registered US trademarks have no disclaimers at all.

Furthermore the remark of the examiner that the list of US registrations we supplied with our Request of Consideration appear to be distinguishable from ours, or are combined with a distinctive matter or are relating to non-related services is simply not the case. We prepared this list very carefully omitted all borderline entries and made sure that all these summarized registrations have at least International Class 42 (webhosting) filed as a service mostly combined with IC's 38 & 45 in case of the entries in the Principal register with the term hosting in their registered trademark.

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C. CONCLUSION

For the foregoing reasons, we respectfully request that the Section 2(e)(1) descriptiveness refusal will be reversed and our mark passed to the publication stage.

In the event that the Board elects to affirm the Section 2(e)(1) descriptiveness refusal for the application, we request alternatively a reversal for the refusal regarding the services under the International Classes 38 and/or 45.

In the event that the Board elects to affirm the Section 2(e)(1) descriptiveness refusal for all the services of the application in the Principal Register, we request further alternatively a registration in the Supplemental Register of the USPTO.

Respectfully submitted,

Your Holding BV
Ceintuurbaan 28
8024 AA Zwolle
The Netherlands

Date: November 24, 2015